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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,911	05/13/2005	Jan Thomas Haines	056222-5075	6725
9629 7590 08/13/2008 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			EXAMINER KAROL, JODY LYNN	
			ART UNIT	PAPER NUMBER
			1617	
			MAIL DATE	DELIVERY MODE
			08/13/2008	PAPER

Please find below and/or attached an Office communication concerning this application, or proceeding.

The time period for reply, if any, is set in the attached communication.



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02/19/2008

EXAMINER

KAROL, JODY LYNN

ART UNIT

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<b>Office Action Summary</b>	Application No. 10/534,911	Applicant(s) HAINES, JAN THOMAS	
	Examiner JODY L. KAROL	Art Unit 1617	

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11/21/2007 and 11/28/2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This Office Action is in response to the amendments and remarks filed on 11/21/2007 and 11/28/2007. Claims 1, 3-5, 8, and 11-12 have been amended and new claim 13 has been added. Accordingly, claims 1-13 are pending and examined on the merits herein.

### ***Response to Arguments***

1. In view of Applicant's amendments to the specification, the objection to the specification in regards to the title and layout are herein withdrawn.
2. In view of Applicant's amendments to claim 11, the objection to claims 11-12 is herein withdrawn.
3. The rejection of claims 3-6, 8 and 11-12 under 35 U.S.C., second paragraph as being indefinite are herein withdrawn in view of Applicant's amendments to claims 3-6, 8 and 11-12.
4. In view of Applicant's amendments to claims 11-12, the rejection of claims 11-12 under 35 U.S.C. 102(b) as anticipated by Bessette et al. (US 6,004,569) are herein withdrawn.

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5. The Applicant's arguments with respect to the rejection of claims 1-4, and 8-9 under 35 U.S.C. 102(b) as anticipated by Bessette et al. (US 6,004,569) have been fully considered but were not found persuasive, and thus the rejection is maintained.

6. The Applicant's arguments with respect to the rejection of claims 1-4, 8-11 under 35 U.S.C. 102(b) as anticipated by Slangan et al. (US 3,917,870) have been fully considered but were not found persuasive, and thus the rejection is maintained.

7. Upon further reconsideration, the rejection of claims 1-4, 8-11 under 35 U.S.C. 103(a) are herein withdrawn.

8. The Applicant's arguments with respect to the rejection of claims 5-7 and 12 under 35 U.S.C. 103(a) have been fully considered but were not found persuasive, and thus the rejection is maintained.

The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set of rejections and/or objections presently being applied in the instant application. They newly applied rejections are necessitated by the amendment of claims 11-12 and the addition of new claim 13.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 8-9, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Bessette et al. (US 6,004,569).

Bessette et al. teaches a pesticide composition comprising alpha-terpineol, eugenol, and cinnamic alcohol dissolved in acetone. The preferred weight percentages are as follows: 10-50% of alpha-terpineol, 10-50% of eugenol, and 20-35% of cinnamic alcohol. Bessette et al. also teaches that preferred blend has equal parts of the components (see column 5, lines 5-10 and claim 5). A 1:1 weight ratio of cinnamic alcohol to eugenol is taught since, for example, 20% of the weight of the composition could be eugenol and 20% could be cinnamic alcohol. Furthermore, from the percentages given, cinnamic alcohol and eugenol are clearly in the pesticide composition in greater than 5%. Therefore, all the limitations of the instant claims 1-4 and 11-12 are met.

Furthermore, Bessette et al. discloses a sample 3B, where it is clear that the only components present in the composition are alpha-terpineol, eugenol, cinnamic alcohol, and acetone (see column 5, lines 5-6). Therefore all the limitations of claim 8 are met.

Bessette et al. teaches that sample 3B as described above, is a pesticide. A pesticide is useful as a consumer product for killing pests. Therefore, all the limitations of claim 9 are also met.

In regards to the instant claim 13, the use of the composition an oral care product is an intended use, and not given any patentable weight. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Furthermore, for the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355. Therefore, the limitations of the instant claim 13 are also met.

10. In response to applicant's arguments, the recitation of "flavour" in the previous claims or "cinnamon flavour" in the amended claims has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

11. In response to Applicant's arguments that the composition taught by Bessette et al. does not anticipate the instant claims because the composition contains acetone, and too much alpha-terpineol is not found persuasive. The term "comprising" is interpreted to be broad and open-ended. Therefore, the presence of other components in the composition taught by Bessette et al. does preclude said composition from anticipating the instant claims. The claimed components are present within the claimed ranges in the composition taught by Bessette et al.; thus, the prior art composition anticipates the claims.

12. Claims 1-4 and 8-11, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Slangan et al. (US 3,917,870).

Slangan et al. teaches a perfume formulation that comprises cinnamic alcohol in 60 parts by weight and eugenol in 20 parts by weight (see column 10, Example VIII). The overall weight percentage of the combination of cinnamic alcohol and eugenol compared to the rest of the composition is greater than 5%. This is determined by comparing the combined parts by weight of cinnamic alcohol and eugenol to the sum of the parts by weight of each component present in the composition. The weight ratio of cinnamic alcohol to eugenol is 3:1 in this particular composition. Cinnamic aldehyde is not listed as a component present in the composition. Additionally, a perfume formulation is considered a consumer product that is a skin care product. Therefore, all the limitations of claims 1-4 and 8-11 are met.



As state above, the use of the composition of the instant claim 13 as an oral care product is an intended use, and not given any patentable weight. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Furthermore, for the purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising." See, e.g., PPG, 156 F.3d at 1355, 48 USPQ2d at 1355. Therefore, the limitations of the instant claim 13 are also met.

13. In response to Applicant's arguments that the composition taught by Slangan et al. does not anticipate the instant claims because the composition contains Lyrar, too much heliotropin, too much aubepine, and large amounts of terpineol is not found persuasive. The term "comprising" is interpreted to be broad and open-ended. Therefore, the presence of other components in the composition taught by Slangan et al. does preclude said composition from anticipating the instant claims. The claimed components are present within the claimed ranges in the composition taught by Slangan et al.; thus, the prior art composition anticipates the claims.

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***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Slangan et al. (US 3,917,870) in view of S. Arctander: "Perfume and Flavor Chemicals", 1969, S. Arctander, Monclair, N.J. (USA) XP002269972.

Slangan et al. is discussed above.

Slangan et al. does not teach a consumer product containing a flavor composition wherein the rate of cinnamic alcohol to eugenol is between 1:1 to 2:1. The ratio taught by Slangan et al. in the perfume composition is 3:1 (see column 10, Example VIII).

Arctander teaches that cinnamic alcohol and eugenol are well-known flavor or fragrance components (see entries 618 and 1369).

Absence a showing of unexpected results, discovery of an optimum value of variable in a known invention is obvious when the parameter is recognized as a result effective variable. See *In re Antoine*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). Cinnamic alcohol and eugenol are well known components with well known characteristics, and are used in flavor or fragrance compositions. Accordingly, the

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optimization of cinnamic alcohol or eugenol in the instant invention is viewed as well within the level of ordinary skill in the art and a matter of routine experimentation.

15. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slangan et al. (US 3,917,870) as applied to claims 1-4 and 8-11 above in view of the online book "Common Fragrance and Flavor Materials" by Bauer et al., published online on 11/5/2001.

Slangan et al. is important for teaching the composition of claim 1 as described above.

Slangan et al. does not teach a composition wherein any of the following additional components of claims 5-7 are included: capsicum, citrus oil, benzyl formate, methyl cinnamate, benzoin, ethyl phenyl glycidate, ginger oil, cinnamyl acetate, and methyl heptenone.

Bauer et al. discloses essential oils, such as citrus peel oils, that are frequently used in the production of flavor or fragrance compositions to impart a desired characteristic or taste (see page 169). For example, citrus oils, and in particular lime oil are added to flavor or fragrance compositions to impart a citrus or lime flavor or aroma (see pages 185-188). Ginger oil is added to flavor or fragrance materials to impart a persistent ginger odor that lacks the pungency of actual ginger (see page 198). Bauer et al. also discloses other flavor and fragrance materials that are not considered essential oils, such as methyl cinnamate or cinnamyl acetate. Methyl cinnamyl acetate

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is added to fragrance compositions to impart a fruity, sweet-balsamic odor (see page 121). Cinnamyl acetate is used to impart cinnamon-fruity effects (see pages 118-119).

Fragrance and flavor components such as lime oil, ginger oil, and methyl cinnamate are well known components in the art, with well-known characteristics and flavors. Therefore, it would be obvious to one of ordinary skill in the art, at the time the invention was made, to include fragrance or flavor component as taught in Bauer et al. to impart an additional desired characteristic or aroma on the fragrance composition of Slangan et al.

The result-effective adjustment in conventional working parameters (e.g., determining an appropriate amount of the components within the composition) is deemed merely a matter of judicious selection and routine optimization which is well within the purview of the skilled artisan.

16. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Slangan et al. teaches a perfume composition, and Bauer et al. teaches components for perfume and

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flavor formulations. As state above, it would be obvious to one of ordinary skill in the art at the time of the invention to include fragrance or flavor component as taught in Bauer et al. to impart an additional desired characteristic or aroma on the fragrance composition of Slangan et al., since the additional component and composition are both used in fragrances.

### ***Conclusion***

No claims are allowed.

Applicant's amendments and addition of new claim 13 necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JODY L. KAROL whose telephone number is (571)270-3283. The examiner can normally be reached on 8:30 am - 5:00 pm Mon-Fri EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

JLK

/SREENI PADMANABHAN/

Supervisory Patent Examiner, Art Unit 1617